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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/672,196 | 09/26/2003 | Paul D. Terpstra | 075698-0106 | 8957 |
| 27433 | 7590 | 05/16/2005 | EXAMINER | |
| FOLEY & LARDNER 321 NORTH CLARK STREET SUITE 2800 CHICAGO, IL 60610-4764 | | | COZART, JERMIE E | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3726 | |

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/672,196

Applicant(s)

TERPSTRA, PAUL D.

Examiner

Jermie Cozart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the segmented tooling assembly attached to a barrel which rotates to wrap the segmented tooling assembly around the barrel in a circular fashion, the center of a segmented tooling assembly attached to a barrel, two ends of the segmented tooling assembly attached to two arms to wrap the segmented tooling assembly around the barrel, unwrapping the segmented tooling assembly from around the barrel, and a track that has both a straight portion and a circular portion must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

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Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claims 23-27 are objected to because of the following informalities: In claim 23, line 2, "material an" in the context used is incorrect therefore it is suggested to change "material an" to - -material to an - -, line 9, "the assembly" does not adequately describe what is bonded, therefore it is suggested to change "assembly" to - -ring and segments- -; In claim 24, line 3, "placing" does not makes the claim confusing, therefore it is suggested to delete "placing"; In claim 25, lines 2-3, "left-hand, right-hand" should be separated by "and", therefore it is suggested to change "," to - -, and- -. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear as to what is meant by the term "one track". Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3, 4, 12, 14, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakayama et al. (4,979,286).

Nakayama discloses a process, wherein a plurality of segments (4) are placed side-by-side, the segments are arranged in a straight line (see figure 1) and a required number are picked up, and the segments are reconfigured in a desired position (i.e. a circular or perpendicular configuration). The segments (4) are picked up with a pick-up device/pick-up head (1) comprising a vacuum cup. The pick-up head (1) is configurable in a circle to place the segments (1) in a circular configuration, and a pick-up device (1) is located on each segment wherein the pick-up device comprises a vacuum cup. See *column 4, lines 42 – column 5, line 55, and figures 1-2 for further clarification.*

Note that for assembling clutch plates and A clutch have not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Note that can be configured in a straight line to pick up a required number of segments, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to

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patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

7. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Huang et al. (5,592,731).

Huang discloses a method for assembling, wherein a plurality of segments (20) are placed side-by-side, a required number of segments are inherently picked up in a straight line they are connected to another, and then the segments are reconfigured in a circular configuration. The plurality of segments (20) are trapezoidal segments and placed side-by-side. See column 5, line 64 – column 10, line 57, and figures 1-10 for further clarification.

Note that for assembling clutch plates has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt (3,630,389) in view of Huang et al. (5,592,731).

Schmidt discloses a pick-up head (25) segmented such that the pick-up head can be configured in a straight line to pick up a required number of segments (not shown), and the pick-up head further being configurable in a circle to place the segments in a circular configuration. The pick-up head comprises a pick-up device (31-34) on each segment wherein the pick-up device comprises a vacuum cup. *See entire document for further clarification.*

Schmidt, however, does not disclose a plurality of segments placed side-by-side wherein the segments are trapezoidal shaped.

Huang discloses a plurality of trapezoidal segments (20) placed side-by-side via wire (37) to provide the segments in a more compact orientation. *See column 5, line 64 – column 10, line 57, and figures 1-10 for further clarification.*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide a plurality of trapezoidal segments side by side for use with the device of Schmidt, in light of the teachings of Huang, in order to provide segments in a more compact orientation for handling.

Note that A clutch assembly have not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

10. Claims 23, 24, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of Wakamori (6,370,755).

AAPA discloses at page 1 of the specification, all of the claimed subject matter except for feeding the segments in a linear configuration to a pick-up station, feeding two parallel strips of friction material into the assembly device, or placing an adhesive on the ring and using one track.

Wakamori discloses feeding the segments (11) in a linear configuration to a pick-up station (i.e. location where the punch contacts the sheet), feeding two parallel strips of friction material (see parallel material supply devices 44, 45 in figure 7) into the assembly device, and placing an adhesive on the ring (12) and using one track. See *column 3, line 23 – column 6, line 21, and figures 2 and 7 for further clarification.*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to feed the segments of AAPA in a linear configuration to a pick-up station, feed two parallel strips of friction material of AAPA into the assembly device,

and to place an adhesive on the ring of AAPA and use one track, in light of the teachings of Wakamori, in order to effectively adhere friction material to a ring.

Note that for assembling a clutch assembly has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

11. Claims 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of Nishimura et al. (6,308,397).

AAPA discloses at page 1 of the specification, all of the claimed subject matter except for cutting the friction material into alternating left-hand, right-hand trapezoids.

Nishimura discloses cutting the friction material into alternating left-hand, right-hand trapezoids (4, 6). See column 3, line 47 – column 4, line 13, and figure 3 for further clarification.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to cut the friction material of AAPA into alternating left-hand and right-hand trapezoids, in light of the teachings of Nishimura, in order to effectively reduce the amount of assembly time.

Note that for assembling a clutch assembly has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded

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any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Double Patenting

12. Claims 1-22 of this application conflict with claims 1-22 of Application No. 10/668,821. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

13. Claims 1-27 of this application conflict with claims 1-27 of Application No. 10/676,513. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

14. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or

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discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

15. Claims 1-22 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-22 of copending Application No. 10/668,821. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

16. Claims 1-27 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-27 of copending Application No. 10/676,513. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jermie Cozart whose telephone number is 571-272-4528. The examiner can normally be reached on Monday-Thursday, 7:30 am - 6:00 pm.

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18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jermie Cozart
Examiner
Art Unit 3726